

REMARKS

Applicant respectfully requests reconsideration of the rejection of claims 1-3, 5, 6, 21, 24, and 25 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al. in view of Kara, U.S. Patent No. 6,505,179. Although the Kara reference was not specifically cited on page 2 of the Office Action, it is assumed that such reference is being asserted by the Examiner due to such reference appearing in the body of the rejection on pages 3-5 of the Office Action. Applicant has amended claim 1, the base independent claim for claims 2-8, to include the patentable feature of the validation system being capable of transmitting information about the ticket to the computer system with the computer system verifying that the ticket is valid and for sending a signal back to the validation system to permit entry to the event. None of the cited prior art teaches or suggests that the computer system receives information about the ticket from the validation system, verifies the ticket, and then sends a signal to the validation system to allow the user entrance to an event. A review of the cited Kara reference and in particular to the passages cited by the Examiner (column 6, lines 8-44 and column 6, line 57 through column 7, line 4) clearly shows that the computer system does not verify the ticket and then send a signal to the validation system to allow the user to enter an event. Kara only discloses that when the initial transaction is consummated processor 42 can operate to transmit information to processor 52 to indicate that certain information has been printed on various tickets. See column 6, lines 29-33 of the Kara patent. Further, the ticket is validated by the processor 52 that is located at the event. The only information that is indicated as being transmitted from the processor 52 to the processor 42 is that a ticket has been validated by the processor 52 and that processor 42 may cancel this information.

in database 43. Again, contrary to the Examiner's position, Kara does not disclose that the computer system validates the ticket when presented for admission to an event.

Further as Applicant has presented previously, there is no reason to combine these cited references in the manner suggested by the Examiner. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 – Section 2143.03 for decisions pertinent to each of these criteria. In this case, none of these criteria have been met.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the applicant's disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole under 35 U.S.C. §103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), *vacated* 475 U.S. 809, 229 USPQ 478 (1986), *aff'd on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

In rejecting all of the claims pending herein, the Examiner has apparently pieced together two or more prior art references, based upon having Applicant's disclosure before him, in concluding that it would have been obvious to combine the references. As the courts have frequently warned the use of "hindsight" in determining obviousness is improper. *In re Manurkar Patent Litigation*, 28 USPQ2d 1801 (N.D. Ill. 1993), is a case in which Judge Easterbrook stated that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis."

Further, Judge Easterbrook stated *Id.* at 1817: With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ... Unless the prior art itself suggest the particular combination, it does not show that the actual invention was obvious or anticipated.

It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. *Grain Processing Corp. v. American Maize-Products Corp.*, 5 USPQ2d 1788, 1792, (Fed. Cir. 1988); *American Medical Systems Inc.*

v. Medical Engineering Corp., 26 USPQ2d 1081, 1091 (E.D. Wis. 1992), *aff'd in part, rev'd in part & remanded*, 28 USPQ2d 1321 (Fed. Cir. 1993).

It is only with the Applicant's disclosure that the Examiner can conclude that it would have been obvious to combine DeLorme et al. with Kara. The DeLorme et al. reference discloses a travel reservation and information planning system. There is no reason to combine the system disclosed in DeLorme et al. with that disclosed in Kara. There is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection of claims is improper.

With respect to the rejection of claim 21, claim 21 has been amended to include the patentable feature of the validation system being connected to the computer system that provided the ticket signal and for transmitting the ticket signal to the computer system with the computer system being capable of validating the ticket signal to determine if entrance to the event should be allowed and for sending a signal back to the validation system to permit entry to the event. As set out above, Kara does not disclose that the computer system validates the ticket when presented for admission to an event. Kara only discloses that the validation system or processor 52 validates the ticket. Further, there is no teaching or suggestion in the cited references themselves to combine the references in the manner suggested by the Examiner.

Regarding the rejection of claims 24 and 25, such claims depend from claim 21 that has been shown to be allowable. In view of this, claims 24 and 25 are allowable for the same reasons.

Applicant requests reconsideration of the rejection of claim 4 under 35 U.S.C §103(a) as being unpatentable over DeLorme and Kara and further in view of a web page timeline distributed by the Uniform Code Council. With respect to the rejection of claim 4, such claim depends from claim 1, the base independent claim, that above has been shown to be allowable. Further, there is no teaching or suggestion in the cited references themselves to combine the references in the manner suggested by the Examiner. It is urged that claim 4 is allowable for the same reasons.

Applicant requests reconsideration of the rejection of claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over DeLorme and Kara and further in view of the attached web page timeline distributed by the Washington Metropolitan Area Transit Authority. Applicant again points out that claims 7 and 8 depend from claim 1, the base independent claim, which has already been shown to be allowable. Further, there is no teaching or suggestion in the cited references themselves to combine the references in the manner suggested by the Examiner. Claims 7 and 8 are now allowable and the §103 rejection should be withdrawn.

Applicant requests reconsideration of the rejection of claims 9 and 17 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al. and Kara and further in view of a web page timeline of press releases distributed by TeamCard. Applicant has amended claim 9, the base independent claim for claims 10-17, to include the patentable feature of the validation system being connected to the computer system for transmitting information about the season pass to the computer system with the computer system verifying that the season pass is valid and for sending a signal back to the validation system to permit entry to the event. None of the cited prior art teaches or suggests that

the computer system that generated the season pass has the capability of validating the season pass and then sending a signal back to the validation system to permit entry to the event. Further, it is only with the Applicant's disclosure that the Examiner can conclude that it would have been obvious to combine DeLorme et al., Kara, and the TeamCard reference. There is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper and should be withdrawn. Claims 10-17 that depend from claim 9 are allowable for the same reasons.

Applicant respectfully requests reconsideration of the rejection of claims 18, 19, and 20. Claim 18 has been amended to include the patentable feature of the validating step comprising sending a validation signal to a computer system that issued the ticket with the computer system for determining if the validation signal is valid and if the validation signal is determined to be valid the computer system sends a signal back to the event to permit entry to the event. Again, none of the cited prior art, alone or in combination discloses this step. Also, there is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. The rejection of claims 18-20 under §103 should be withdrawn.

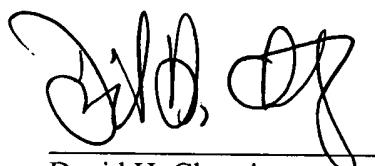
Applicant respectfully requests reconsideration of the rejection of claim 22 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al. and Kara and further in view of Sehr, U.S. Patent No. 6,386,451. Claim 22 depends from claim 21 that was shown to be allowable. Further, there is no reason to combine the references in the

manner suggested by the Examiner. It is submitted that claim 22 is now allowable and the §103 rejection should now be withdrawn.

Applicant respectfully requests reconsideration of the rejection of claim 23 under 35 U.S.C §103(a) as being unpatentable over DeLorme et al., Kara, and Sehr and further in view of the UCC timeline. Claim 23 depends from claim 21 that was shown to be allowable. Further, there is no reason to combine the references in the manner suggested by the Examiner. In view of the amendment to claim 21 and the above remarks, it is submitted that claim 23 is now allowable and the §103 rejection should be withdrawn.

Applicant submits that upon entry of the amendment to the claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicant's counsel requests the Examiner to telephone the undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,



David H. Chervitz
Registration No. 32,820
POLSTER, LIEDER, WOODRUFF
& LUCCHESI, L.C.
12412 Powerscourt Drive, Suite 200
St. Louis, Missouri 63131-3615
(314) 238-2400